



#9

Our Docket No: 3099P017

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of:)
)
Britton)
)
Serial No.: 09/412,993) Art Unit: Not Yet Assigned
)
Filed: October 5, 1999)
)
For: PROVIDING AUDIENCE FLOW IN A PERSONAL) Examiner: Not Yet Assigned
TELEVISION DEVICE)
)
)
)
)

RENEWED PETITION UNDER 37 CFR 1.137(b)

In response to the dismissed Petition Under 37 CFR 1.137(b) filed May 9, 2001, and dismissed June 19, 2001, the following items are being submitted for reconsideration of the originally filed Petition.

- I. Copies of:
- a. The decision dismissing the Petition.
 - b. The Petition.
 - c. The Response to Notice to File Missing Parts filed on May 9, 2001 submitted with the Petition, and evidencing that the filing fee and surcharge were previously paid.
- II. A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, supplemented by additional facts. While this statement and additional facts were not required by the Petitions Examiner, they are being provided because the Petition was filed more

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than three months from the date the applicant was first notified that the application had become abandoned, and because the Petition was filed more than one year from the date of abandonment.

III. The required reply. While the Petitions Examiner has requested a signed Declaration, a Declaration under 37 CFR 1.47(b) for refusal of all inventors to execute an application is being submitted. In accordance with MPEP §409.03(b), the following requirements must be met:

- a. The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175.
- b. The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.
- c. The application must be accompanied by proof that the inventor (1) cannot be found or reached after a diligent effort or (2) refuses to execute the application papers.
- d. The last known address of the inventor must be stated.
- e. The 37 CFR 1.47(b) applicant must make out a *prima facie* case (1) that the invention has been assigned to him or her or (2) that the inventor has agreed in writing to assign the invention to him or her or (3) otherwise demonstrate a proprietary interest in the subject matter of the application.
- f. The 37 CFR 1.47(b) applicant must prove that the filing of the application is necessary (1) to preserve the rights of the parties or (2) to prevent irreparable damage.

Item A is evidenced by the attached DECLARATION AND POWER OF ATTORNEY, and the accompanying ADDENDUM TO COMBINED DECLARATION AND POWER OF ATTORNEY FOR SIGNATURE BY PERSON

WITH SUFFICIENT PROPRIETARY INTEREST WHERE NO INVENTOR IS AVAILABLE TO SIGN AND ON BEHALF OF ALL THE INVENTORS WHO REFUSE TO SIGN OR CANNOT BE REACHED, and Item B and D are stated in the ADDENDUM.

Item C is evidenced by the STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF NON-SIGNING INVENTOR.

Item E is demonstrated by the STATEMENT ESTABLISHING PROPRIETARY INTEREST BY PERSON SIGNING ON BEHALF OF NONSIGNING INVENTOR and accompanying STATEMENT ON BEHALF OF ENTITY WITH SUFFICIENT PROPRIETARY INTEREST THAT NONSIGNING INVENTOR WAS EMPLOYEE OR OTHERWISE OBLIGATED TO ENTITY WITH SUFFICIENT PROPRIETARY INTEREST WHEN INVENTION MADE and LEGAL MEMORANDUM IN SUPPORT OF PROPRIETARY INTEREST.

Item F is shown in the STATEMENT ESTABLISHING PROPRIETARY INTEREST BY PERSON SIGNING ON BEHALF OF NONSIGNING INVENTOR.


- IV. A petition for a four month extension of time to reply to the dismissed Petition, and the required fee of \$1440.
- V. A petition to file on behalf of a non-signing inventor, and the required fee of \$130 under 37 CFR 1.17(h).

Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: December 19, 2001



Libby H. Hope
Reg. No. 46,774

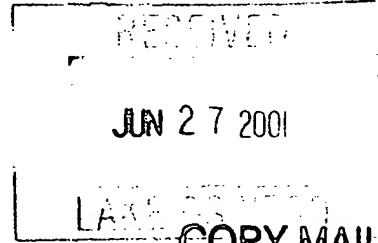
12400 Wilshire Boulevard
7th Floor
Los Angeles, California 90025-1026
(303) 740-1980



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

GREGORY D CALDWELL
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90024



Paper No. 7

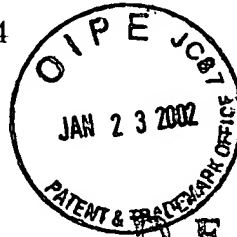
FDL
Replay IV
Inc.

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JUN 19 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of
Layne Britton
Application No. 09/412,993
Filed: October 5, 1999
Attorney Docket No. 3099P017



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BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
LOS ANGELES

This is a decision on the petition under 37 CFR 1.137(b), filed May 14, 2001, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed November 1, 1999. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on January 2, 2000.

A grantable petition under 37 CFR 1.137(b)¹ must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37

¹ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

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CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item (1).

This application became abandoned for failure to file a reply to the Notice of File Missing Parts of Application (Notice) mailed November 1, 1999. The reply required for consideration of a petition to revive must be a signed declaration.

Since petitioner has filed to submit the reply required by 37 CFR 1.137(b)(1), the petition must be dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

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Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Due date 8/19/2001 Client Name ReplayTV, Inc
Jocket Initial 3099, P017
Jock. Sup. Initial GDC
Atty/Initial
Pat/Ser/Reg 412,993
Description
Response due: Request for reconsideration

Abraham Chavez

2/6/2001

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

3099P017

First named inventor: LAYNE BRITTON

Application No.: 09/412,993

Group Art Unit: 2712

Filed: October 5, 1999

Examiner: Not Yet Assigned

Title: PAY PER VIEW ARCHITECTURE PROVIDING FOR LOCAL STORAGE OF CONTENT

Attention: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8, 1995; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

- ☐ Small entity - fee \$ 620.00 (37 CFR 1.17(m))
Small entity statement enclosed herewith
Small entity statement previously filed
- ☒ Other than small entity - fee \$ 1,240.00 (37 CFR 1.17(m))

2. Reply and/or fee

- A. The reply and/or fee to the above noted Office Action
in the form of Response to Notice to File (identify type of reply):
Missing Parts
- ☐ has been filed previously on
- ☒ is enclosed herewith.
- B. The issue fee of \$ 1,240.00
- ☐ has been paid previously on
- ☐ is enclosed herewith.

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 1.0 hour to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$55.00 for a small entity or \$110.00 for other than a small entity) disclaiming a period equivalent to the number of months from the date of abandonment to the filing of this petition is enclosed herewith.

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

May 9, 2001

Date

Telephone

Number: (503) 684-6200

Signature

Gregory D. Caldwell, Reg. No. 39,926

Typed or printed name

12400 Wilshire Boulevard, Seventh Floor

Address

Los Angeles, California 90025

- Enclosures: ☒ Fee Payment
☒ Reply
☐ Terminal Disclaimer Form
☐ Small Entity Status Form
☐

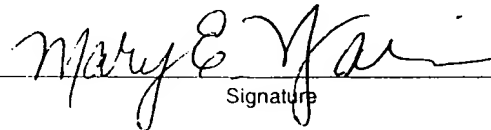
CERTIFICATE OF MAILING/TRANSMISSION [37 CFR 1.8(A)]

I hereby certify that this correspondence is being:

- ☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.
- ☐ transmitted by facsimile on the date shown below to the Patent and Trademark Office at (703) 308-6916.

May 9, 2001

Date



Signature

Mary E. Warinner

Typed or printed name of person signing certificate



Attorney's Docket No.: 03099.P017

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
Layne Britton) Group Art Unit: 2712
Application No.: 09/412,995) Examiner: Not Yet Assigned
Filed: October 5, 1999)
For: PROVIDING AUDIENCE FLOW IN A)
PERSONAL TELEVISION DEVICE)

Box Missing Parts
Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO NOTICE TO FILE MISSING PARTS
FILING DATE GRANTED

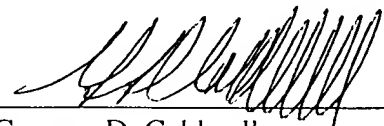
Sir:

In response to the Notice to File Missing Parts, Filing Date Granted, dated
November 1, 1999, enclosed please find the following:

- 1) The statutory basic filing fee, and
- 2) The surcharge of \$130.00 as set forth in 37 CFR 1.16(e).

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 5/9/01



Gregory D. Caldwell
Reg. No. 39,926

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026
(503) 684-6200



**ADDENDUM TO PETITION FOR REVIVAL OF APPLICATION
UNINTENTIONALLY ABANDONED**

4. Statement: The entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.
- a. The facts of the case are as follows:
- i. The application in question was filed on October 5, 1999 for inventor Mr. Layne Britton, who was, at the time, employed by REPLAYTV, INC., incorporated in California.
- ii. The application was filed by REPLAYTV's in-house attorney at the time, Mr. David Halvorson, on behalf of REPLAYTV. The fact that this application was filed was unknown to officers of the company at this time.
- iii. A Notice to File Missing Parts of Application was mailed by the USPTO on November 1, 1999, and the case became abandoned on January 2, 2000 for failure to respond to the Notice to File Missing Parts. A Notice of Abandonment was mailed on September 26, 2000.
- iv. On May 14, 2001, a Petition for Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) was filed. The Petition was dismissed on June 19, 2001 for failure to submit the required reply in the form of a signed declaration.

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b. The delay in filing the Petition for Revival is explained below:

i. When the Notice to File Missing Parts was received at REPLAYTV in November, 1999 2000, REPLAYTV's in-house patent attorney, Mr. Halvorson, who filed the application, had already left the company. Shortly thereafter, the communication was rerouted, in due course, to an officer of REPLAYTV, Craig Dougherty, Chief Financial Officer. Such communication was the first indication to others in the company that Mr. Halvorson filed the patent application on behalf of REPLAYTV.

ii. This communication and information was forwarded to the Lake Oswego, Oregon office of the law firm of Blakely, Sokoloff, Taylor, & Zafman, LLP ("BSTZ") for investigation on or around November 15, 2000.

iii. On November 22, 2000, a Revocation and Power of Attorney was filed with the USPTO, providing the law firm of Blakely, Sokoloff, Taylor, & Zafman, LLP, and its attorneys with Power of Attorney in this matter. A Notice Regarding Power of Attorney was mailed by the PTO on April 20, 2001, acknowledging the new Power of Attorney.

iv. For some time after November 22, 2000, attempts were made by both REPLAYTV and BSTZ to determine the whereabouts of the application in question and related correspondences, as well as the whereabouts of the inventor on the application, Mr. Britton, who had left REPLAYTV by that time.

v. Subsequently, BSTZ authorized its Washington, DC agent, Mr. James Thein, to obtain the file for inspection, and on April 20, 2001 (the same day that the Notice Regarding Power of Attorney was mailed), the file was inspected and copied.

vi. Having facts in hand, a Petition for Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) was filed shortly thereafter on May 14, 2001.

vii. Thus, the entire delay in filing the required reply from the due date for the reply, January 1, 2001, until the filing of a grantable petition under 37 CFR 1.137(b), May 14, 2001 was unintentional.

c. The Petition for Revival was filed more than three months from the date the applicant was first notified that the application was abandoned because the applicant was not aware that an application had been filed; the applicant did not understand the nature of the document received; there were insufficient facts or supporting documents to support the filing of a Petition for Revival; and since the applicant first became aware that the application had been abandoned around September 26, 2000 (the date the Notice of Abandonment was mailed), it took a substantial amount of time to determine what had been filed, to determine where the application and related correspondences were, and to exchange correspondences with those involved in the matter, as well as those who could assist with the matter.

d. The Petition for Revival was filed more than one year from the date of abandonment because the applicant was not aware that an application had been filed; the applicant did not understand the nature of the document received; there were insufficient facts or supporting documents to support the filing of a Petition; and since the applicant first became aware that the application had been abandoned around September 26, 2000 (the date the Notice of Abandonment was mailed), it took a substantial amount of time to determine what had been filed, to determine where the application and related correspondences were, and to exchange correspondences with those involved in the matter, as well as those who assisted with the matter.

Dated: December 19, 2001



Libby H. Hope
Reg. No. 46,774

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